

REMARKS

Claims 1-30 are pending in the application.

Claims 1-30 are rejected.

Claims 1, 8, 12-13, 15, 17, 22-23 and 29-30 are amended.

Reconsideration and allowance of claims 1-30 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guheen et al (U.S. Patent No. 6,957,186) (Guheen hereinafter) and O'Conner et al (U.S. Patent No. 5,745,568) (O'Connor hereinafter). This rejection is not applicable to the amended claims.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluation. However, the references, alone, or in any combination, do not teach all limitations of the claims.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

Claim 1 includes, in part, "responsive to a customer order or plan, assembling distinct computer and storage system components for creation of a given solution-based product as a function of the customer order or plan; assigning a solution identifier to the solution-based product, wherein the solution identifier includes a solution type and a unique identifier within the solution type, and wherein there is only one solution identifier assigned to the solution based product; storing the solution identifier in a table; and using the solution identifier to assist on-line support of the solution-based product." Guheen does not teach responsive to a customer order or plan, assembling distinct computer and storage system components for creation of a given solution-based product as a function of the customer order or plan, assigning a solution identifier to the solution-based product, wherein the solution identifier includes a solution type and a unique identifier within the solution type, and wherein there is only one solution identifier assigned to the solution based product, storing the solution identifier in a table, and using the solution identifier to assist on-line support of the solution-based product.

Applicants agree with the Office Action's assertion that Guheen fails to teach a solution identifier that is assigned to the solution-based product, wherein the solution identifier includes a solution type and a unique identifier within the solution type. page 6, lines 1-3. Additionally, because Guheen fails to teach the solution identifier, Guheen also fails to teach storing the solution identifier in a table and using the solution identifier to assist on-line support of the solution-based product.

O'Connor fails to make up for these deficiencies. O'Connor teaches a hardware identifier that is used as an encryption key for a CD-ROM and that in order for the hardware identifier to be used as a decryption key, the software and hardware must have matching hardware identifiers. col. 3, line 54 – col. 4, line 16. This does not teach storing the solution identifier in a table and using the solution identifier to assist on-line support of the solution-based product. For at least this reason, the USPTO's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 1. Independent claims 8, 15, 23 and 29-30 are patentable at least for similar reasons as described for representative claim 1.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claims 8, 15, 23 and 29-30, and to the claims which depend therefrom.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ___, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

In the present case, the Examiner has not expressed a reason why a person of ordinary skill in the art would combine Guheen with O'Connor as required by the claims. Guheen does not disclose storing a solution identifier in a table and using the solution identifier to assist on-line support of the solution-based product. O'Connor does not disclose storing a solution identifier in a table and using the solution identifier to assist on-line support of the solution-based product. If Guheen is combined with O'Connor, as suggested by the Office Action, the result would be, at best, offering software services on a CD-ROM for exclusive retrieval by a specified computer, and would not be storing a solution identifier in a table and using the solution identifier to assist on-line support of the solution-based product as is required by the claims. See O'Connor Abstract; Guheen col. 7, lines 53-56; Guheen col. 8, lines 20-27 and 34-36; Guheen col. 14, line 62 – col. 22, line 45. In view of the above, a person of ordinary skill in the art would not have a reason to combine the Guheen with O'Connor. Therefore, there is

simply no basis for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

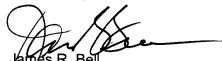
Therefore, independent claims 1, 8, 15, 23 and 29-30, and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1-30 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


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